

REMARKS

Summary of Prosecution and Status of Claims

Applicant filed the present application on December 4, 2001 with 50 claims. Through a preliminary amendment filed with the application, claim 50 was cancelled prior to examination. Through the same preliminary amendment, claims 51-67 were added.

A first non-final office action was mailed March 13, 2003. Applicant traversed the rejections in a response dated June 9, 2003.

A final office action was mailed August 25, 2003. In a response dated October 23, 2003, the Applicant traversed the Examiner's rejections in addition to canceling claims 49, 60-62 and 65; claims 1-48, 51-59, 63-64 and 66-67 remained pending.

An advisory action was mailed March 10, 2004 subsequent to the Applicant's filing of a Notice of Appeal to the Board of Patent Appeals and Interferences dated February 23, 2004. Applicant filed its appeal brief March 25, 2004.

In an Advisory Action and Interview Summary dated September 3, 2004, the Examiner indicated a new non-final office action would be forthcoming. That non-final office action was mailed January 7, 2005 and is the subject of the present amendment and response. Claims 1-48, 51-59, 63-64 and 66-67 are pending.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1-17, 35-43, 51-53, 57-59 and 66 as being rejected under 35 U.S.C. § 112, ¶ 2 "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." *Office Action*, 2 at ¶ 1. Specifically, the Examiner noted that claims 1 and 35 recited the limitation "said prioritized communications" and, in claims 66 and 67, the limitation "the items prioritized." *Office Action*, 2 at ¶ 1. In both instances, the Examiner contends

there to be “insufficient antecedent basis for [these] limitations in the claims.” *Office Action*, 2 at ¶ 1.

Applicant notes that the initial list of claims identified by the Examiner as having been rejected (claims 1-17, 35-43, 51-53, 57-59 and 66) omits claim 67. Claim 67 was specifically referenced by the Examiner, above, as being indefinite for want of antecedent basis.

Applicant has cancelled claims 1-17, 35-43, 51-53, 57-59 and 66 making the Examiner’s 35 U.S.C. § 112, ¶ 2 rejection moot as it pertains to these claims. The Applicant has amended claim 67 to recite, *inter alia*, the step of “storing the items, *which are prioritized*,” versus the previously recited “the items prioritized” (emphasis added). Applicant believes this amendment overcomes the Examiner’s 35 U.S.C. § 112, ¶ 2 rejection as it pertains to claim 67.

In light of the cancellation of claims 1-17, 35-43, 51-53, 57-59 and 66 and the amendment of claim 67, Applicant believes the 35 U.S.C. § 112, ¶ 2 rejections to have been overcome in their entirety.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1-9, 11-26, 28-42, 44-46, 51-59 and 66 under 35 U.S.C. § 102(e) as being anticipated by U.S. patent number 6,654,726 to Hanzek (*Hanzek*).

Applicant has cancelled claims 1-9, 11-26, 28-42, 44-46, 51-59 and 66 making the Examiner’s 35 U.S.C. § 102(e) rejection moot.

In light of the cancellation of claims 1-17, 35-43, 51-53, 57-59 and 66, Applicant believes the 35 U.S.C. § 102(e) rejections to have been overcome in their entirety.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 10, 27, 43, 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over *Hanzek*.

Applicant has cancelled claims 10, 27, 43, 47 and 48 making the Examiner's 35 U.S.C. § 102(e) rejection moot.

In light of the cancellation of claims 10, 27, 43, 47 and 48, Applicant believes the 35 U.S.C. § 103(a) rejections to have been overcome in their entirety.

Double Patenting Rejection

The Examiner rejected claims 1, 12, 15, 18, 29, 35 and 46 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. patent number 6,408,277 B1. *Office Action*, 11 at ¶ 4.

Claims 1, 12, 15, 18, 29, 35 and 46 have been cancelled thereby making the Examiner's double patenting rejection moot.

In light of the cancellation of claims 1, 12, 15, 18, 29, 35 and 46, Applicant believes the double patenting rejections to have been overcome in their entirety.

Allowable Subject Matter

The Examiner identified claims 63 and 64 as being allowed. *Office Action*, 12 at ¶ 6. Applicant thanks the Examiner for identifying this allowable subject matter.

The Examiner further identified claim 67 as being "allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph." *Office Action*, 12 at ¶ 5. Applicant, again, thanks the Examiner for identifying this allowable (albeit objected to) subject matter. As noted in the Applicant's remarks as they pertain to the 35 U.S.C. § 112, ¶ 2 rejections, Applicant believes this rejection has been overcome.

Applicant therefore contends that claim 67—as well as claims 63 and 64—are in condition for allowance.

CONCLUSION

Claims 1-48, 51-59, 63-64 and 66-67 were pending. Applicant has cancelled—without prejudice—claims 1-48, 51-59 and 66. Applicant's cancellation of these claims is not meant to be interpreted as accepting the basis of rejection of these claims as proffered by the Examiner but means of expediting allowance of the present application. The Applicant expressly reserves the right to pursue these cancelled claims in a continuation application.

Claims 63-64 and 67 remain pending following this amendment. Claims 63 and 64 were identified by the Examiner as representing allowable subject matter. Claim 67 was objected to for lack of antecedent basis under 35 U.S.C. § 112, ¶ 2. Applicant believes the present amendment of claim 67 overcomes that rejection and claim 67 is now in condition for allowance.


With only allowable claims pending, the Applicant respectfully requests the issuance of a *Notice of Allowance*. In the event this application is passed to allowance, the Examiner is respectfully requested to ensure proper consideration of (1) the *Information Disclosure Statement* submitted January 18, 2005; (2) the *Invitation for Determination* submitted February 17, 2005 and (3) the *Information Disclosure Statement* submitted herewith.

The Examiner is invited to contact the Applicant's undersigned representative with any questions concerning this amendment.

Respectfully submitted,
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